



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/593,468

09/19/2006

Huminori Ikeda

Q97089

2775

23373 7590 05/26/2011
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

DUCHENEAUX, FRANK D

ART UNIT

PAPER NUMBER

1788

NOTIFICATION DATE

DELIVERY MODE

05/26/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com
PPROCESSING@SUGHRUE.COM
USPTO@SUGHRUE.COM

Office Action Summary

Application No.

10/593,468

Applicant(s)

IKEDA ET AL.

Examiner

FRANK D. DUCHENEAUX

Art Unit

1788

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner's Note

1. The Examiner acknowledges the cancellation of claim 3 in the amendments filed 3/7/2011.

Response to Amendment

2. Applicant's arguments, see pages 4-5 of the remarks, filed 3/7/2011, with respect to the rejection of claims 1, 3 and 5-8 under 35 U.S.C. 112, 1st paragraph as set forth in paragraph 4 of the action mailed 12/9/2010 have been fully considered and are persuasive. The rejection of claims 1, 3 and 5-8 has been withdrawn.
3. Applicant's arguments, see page 5 of the remarks, filed 3/7/2011, with respect to the rejection of claim 3 under 35 U.S.C. 112, 2nd paragraph as set forth in paragraph 6 of the action mailed 12/9/2010 have been fully considered and are persuasive. The rejection of claim 3 has been withdrawn.

Rejections

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 1 and 5-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugino et al. (JP 2003-313330) in view of Konuma (JP 05309799 A) and Fritsch (US 3088848), and in further view of Watanabe et al (US 5795650). The Examiner notes that citations from the ~330 reference were taken from a human translation and the citations from the ~799 reference were taken from a machine translation (with further interpretation provided by office translators), both of which are provided with the current action.

Regarding claims 1 and 5-8, Sugino teaches a polyolefin-based resin laminated film (title) comprising a coating film layer and a polyolefin-based resin substrate film (surface substrate film) (para 0012) suitable for industrial adhesive films and having excellent properties such as durability curve following properties, weatherability, etc. (para 0001), which said substrate film

Art Unit: 1788

is formed via inflation forming method (para 0028, lines 1-4), has thickness of 40 to 200 μm (para 0029), and has a tensile modulus of 300 to 900 MPa (para 0019, lines 1-4).

Sugino also teaches that the substrate film is made of polyethylene resins (para 0013) such as low-density polyethylene (LDPE) **linear** low-density polyethylene (LLDPE) and high density polyethylene (HDPE), and contains a UV absorber (para 0020) such as 2,2'-dihydroxy-4-methoxybenzophenone (para 0021), which is identical to the ultraviolet absorbers presently disclosed, in an amount of 0.05 to 5 parts by weight per 100 parts by weight of the polyolefin resin (para 0023).

Sugino is silent to an HDPE having a density of 0.950 to 0.959 g/cm^3 and an LLDPE having a density of 0.923 to 0.933 g/cm^3 , which is present in an amount of 50 to 90 parts by mass relative to 100 parts by mass of the mixture HDPE/LDPE mixture, and to a PSA layer having a thickness of 20 to 200 μm on one surface of the surface substrate, said PSA layer formed of an acrylic resin-based PSA obtained by crosslinking an acrylic polymer having a weight average molecular weight of 500,000 to 1,100,000 with a polyisocyanate compound.

However, Sugino does teach adhesive tapes formed from the polyolefin-based resin laminates and an adhesive agent layer (para 0061), made of acryl-type adhesive agents, which can be of any form such as solvent, emulsion, hot-melt, etc., and tackifiers, softeners, etc. (para 0062), and which are well know components of acrylic PSA compositions.

Konuma teaches a surface protection film comprising an outer layer (claim 1) formed of a 40:100 weight ratio (approx 70 parts per 100 parts HDPE/LDPE) of HDPE having a density of 0.954 g/cm^3 to LDPE having a density of 0.928 g/cm^3 (para 0020).

Art Unit: 1788

Fritsch teaches a pressure-sensitive-adhesive tape having a backing comprising a blend of high and low density polyethylene (title), which said blend provides improvement in vapor transmission, gas permeability, abrasion resistance and high temperature resistance (column 2, lines 23-28), whereas a drastic reduction in elongation occurs when the amount of HDPE exceeds 50 % (column 3, lines 1-4).

Given that Sugino and Konuma teach a polyethylene resin substrate film identical to that presently claimed, to include identical low- and high-density polyethylenes in identical amounts and an identical UV absorber in identical amounts, it is reasonable that substrate film disclosed by the combined references would provide the presently claimed spectral transmittance.

Sugino, Konuma and Fritsch are silent to a PSA layer having a thickness of 1 to 300 μm , and an acrylic polymer having a weight-average molecular weight of 500,000 to 1,100,000 crosslinked with a polyisocyanate compound.

However, Watanabe teaches a teaches a pressure sensitive adhesive sheet comprising a PSA layer having a thickness of 5 to 150 μm (column 6, lines 15-23) and PSA having a polymer with a weight-average molecular weight of from 800,000 to 1,800,000, which significantly overlaps that presently claimed, to maintain a firm bonding between the PSA and a base layer (column 4, lines 28-37).

As set forth in MPEP 2144.05, in the case where the claimed range “overlap or lie inside ranges disclosed by the prior art”, a *prima facie* case of obviousness exists, In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Art Unit: 1788

Watanabe also teaches that said polymer is an acrylic (column 3, lines 42-44) containing carboxylic acid group-containing monomers (column 3, lines 60-62), and said PSA further comprising isocyanate crosslinking agents (column 4, lines 19-22) such as diisocyanate (polyfunctional) (column 8, lines 13-14).

The recitation in the claims that the claimed invention is “for a motor vehicle brake disc antirust film for adhering onto a motor vehicle wheel” is merely an intended use. Applicants attention is drawn to MPEP 2111.02 which states that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that the prior art discloses a PSA layer formed on a substrate as presently claimed, it is clear that the disclosed invention of prior art combination would be capable of performing the intended use, i.e. for adhering onto a motor vehicle wheel, presently claimed as required in the above cited portion of the MPEP.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the Sugino, Konuma, Fritsch and Watanabe references towards a PSA tape

Art Unit: 1788

comprising a PSA layer composed of well known polyisocyanate-crosslinked acrylic polymers, said polymer being of a molecular weight as presently claimed towards an adhesive layer with firm bonding between said PSA layer, and comprised of a backing having elongate properties and simultaneous improvement in vapor transmission, gas permeability, abrasion resistance and high temperature resistance as in the present invention.

Response to Arguments

8. Applicant's arguments, see the claim amendments and pages 5-10 of the remarks filed 3/7/2011, with respect to the rejections of **claims 1, 3, 5 and 7-8** over Ukei et al. in view of Endo under 35 U.S.C. 103(a) and **claim 6** over Ukei et al. in view of Endo and Watanabe et al. under 35 U.S.C. 103(a) as set forth in paragraphs 9 and 10 of the action mailed 12/9/2010, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1788

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK D. DUCHENEAUX whose telephone number is (571)270-7053. The examiner can normally be reached on M-Th, 7:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alicia A. Chevalier can be reached on (571)272-1490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia Chevalier/
Supervisory Patent Examiner, Art Unit 1788

/F. D. D./
Frank D. Ducheneaux
Examiner, Art Unit 1788
5/20/2011